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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,100	03/26/2001	Rabindranath Dutta	AUS920010152US1	7732

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EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/817,100

Applicant(s)

DUTTA ET AL.

Examiner

Matthew s Gart

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-10 are rejected under 35 U.S.C. 101.**

Referring to claims 1-10. The claimed invention is directed to non-statutory subject matter. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58 are not patentable.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

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In the instant invention, the claims are anticipated by a mental process augmented by pencil and paper markings. The instant claims are not limited to using a machine to carry out the process since the claims do not explicitly set forth the machine.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 10 and 20 are rejected under 35 U.S.C. 112 second paragraph.**

Referring to claims 10 and 20. Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 20 recite the limitation "said crediting." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 8-12 and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsunenari Patent Application Publication US 2002/0013744.**

Referring to claim 1. Tsunenari discloses a method for processing a return of an item purchased from a selling merchant by a remote customer, said method comprising (abstract):

- Receiving an order for said item from said customer (paragraph 0013 through paragraph 0018);
- Sending said item to said customer by said selling merchant (paragraph 0013 through paragraph 0018);
- Receiving a return communication from said customer requesting a return of said item to said selling merchant (Fig. 8 and Fig. 10G); and
- Sending a shipping communication to said customer, said shipping communication identifying a receiver other than said selling merchant to whom said item is to be returned (Fig. 2A, Fig. 10H and Fig. 10I).

Referring to claim 2. Tsunenari further discloses a method including receiving a return receipt notice from said receiver when said item has been received by said reseller (paragraph 0104).

Referring to claims 8-10. Tsunenari further discloses a method wherein:

- Said receiving of said return request and said sending of said shipping communication are accomplished by email communication (Fig. 2A and Fig. 10D);
- Said return receipt notice is accomplished by email (Fig. 2A and Fig. 10D); and
- Said notice of said crediting is accomplished by email (paragraph 0077).

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Referring to claims 11-12. Claims 11-12 are rejected under the same rationale as set forth above in claims 1-2.

Referring to claims 18-20. Claims 18-20 are rejected under the same rationale as set forth above in claims 8-10.

Referring to claims 21-22. Claims 21-22 are rejected under the same rationale as set forth above in claims 1-2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-7, 13-17 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunenari Patent Application Publication US 2002/0013744 in view of Siegel Patent Application Publication US 2001/0032147.**

Referring to claims 3-7. Tsunenari does not expressly disclose a method wherein said method further includes:

- Charging a designated customer account after receiving said order;
- Crediting said customer account after receiving said return receipt notice from said receiver;
- Effecting an auction of said item following said receiving of said return communication from said customer, said receiver being a winner of said auction; and

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- Maintaining a database for storing information concerning said customer, said item and said receiver, said database being updated upon receipt of an order, a return request or a return receipt notice.

Siegel discloses a method wherein said method further includes:

- Charging a designated customer account after receiving said order (Siegel: claim 20);
- Crediting said customer account after receiving said return receipt notice from said receiver (paragraph 0037);
- Effecting an auction of said item following said receiving of said return communication from said customer, said receiver being a winner of said auction (paragraph 0009); and
- Maintaining a database for storing information concerning said customer, said item and said receiver, said database being updated upon receipt of an order, a return request or a return receipt notice (paragraph 0009 and paragraph 0037).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Tsunenari to have included the limitations of Siegel as discussed above because upon returning unwanted purchases consumers generally expect to immediately receive cash or credit for their returns (Siegel: paragraph 003).

Furthermore, the systems and method of Tsunenari is enabled to be used to effect product return for any reason, such as product service, product repair, customer dissatisfaction, etc. Various modifications are possible (Tsunenari: paragraph 0126).

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Referring to claims 13-17. Claims 13-17 are rejected under the same rationale as set forth above in claims 3-7.

Referring to claims 23-25. Claims 23-25 are rejected under the same rationale as set forth above in claims 3-7.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Junger, US Patent No. 6,269,344 B1, July 31, 2001, discloses a method and apparatus for efficient handling of product return transactions.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



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October 20, 2003

A handwritten signature in black ink, appearing to read "Vincent Millin".

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3800